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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,454	11/15/2000	Louise Bailey	57,0291 US PC	5454

7590 05/20/2003

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EXAMINER
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TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/20/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

A3-14

# Office Action Summary

Application No.

622454

Applicant(s)

BAILEY ET AL.

Examiner

P. TOCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 3/10/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 9-12, 15-18, 20, 21, 23, 24, 26-28, 30, 31 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 9-12, 15, 16, 26-28, 30, 31 is/are allowed.
- ☒ Claim(s) 17, 18, 20, 21, 23, 24 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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## DETAILED ACTION

### *Claim Objections*

1. Claims 18 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 18 and 20 contain additives which fail to further limit the additive of claim 17.


2. Claims 17, 18, 20, 21, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4404219.

DE '219 teaches a water based clay composition which comprises a phosphonate according to the present invention (see succinic acid derivative IIa on page 2), and may contain salts such as sodium silicate or sodium metaphosphate (see page 3, lines 16-19, and examples). The composition may be used as a drilling mud (page 2, lines 5-8). The discovery by applicant of an inherent property of reducing cuttings accretion and bit balling for the phosphonate additives does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623). The present invention is thus anticipated by DE '219.

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3. Claims 9-12, 15, 16, 26-28, 30 and 31 are allowable over the art of record.
4. Applicants amendments are noted. The examiner inadvertently indicated that claim 19 would be allowable over the DE '219 reference. DE '219 clearly teaches a phosphor derivative of succinic acid IIa and thus anticipates the current claims as amended. New objections are also presented.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2806  
May 15, 2003

  
**PHILIP C. TUCKER**  
**ART UNIT 1712**